

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

New claims 7-11 have been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-11 are now pending in this application.

Statement of Common Ownership

Application 10/534,576 and U.S. Patent No. 6,851,468 were, at the time the invention of Application 10/534,576 was made, owned by BEHR GmbH & Co.

While Application 10/534,576 is assigned to BEHR LORRAINE S.A.R.L., Applicants note that BEHR LORRAINE S.A.R.L. is owned 100% by BEHR GmbH & Co. Applicants believe that this situation meets the definition of "common ownership" set forth in MPEP §706.02(I)(2)(I).

Information Disclosure Statement

Applicants gratefully acknowledge the signed and initialed copy of the PTO/SB/08 form filed with an Information Disclosure Statement by Applicants on May 11, 2005. However, documents A4 and A5 were not initialed. Applicants respectfully request consideration of documents A4 and A5, and a signed and initialed copy of the PTO/SB/08 form with the next Office correspondence.

Applicants note that when a listed reference is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. See M.P.E.P. § 609.04(a), Part III. A copy

of the search report indicating the relevance of documents A4 and A5 was submitted with the Information Disclosure Statement. Furthermore, as noted in the Information Disclosure Statement, documents A2 and A4 belong in the same “patent family.” Therefore, document A2 may assist the Office in understanding the content of document A4.

Objection to the Specification

The Office requests the submission of an Information Disclosure Statement for application 101 54 891.5 cited in Applicants’ specification. An Information Disclosure Statement will be filed to submit this document. Reconsideration and withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-4 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,946,940 to Inoue (hereafter “Inoue”) in view of U.S. Patent No. 6,851,468 to Kaspar *et al.* (hereafter “Kaspar”). In addition, claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue and Kaspar, and further in view of U.S. Patent No. 5,537,839 to Burk *et al.* (hereafter “Burk”). These rejections are respectfully traversed.

Inoue is a patent that was commonly owned at the time that this invention was made. See statement of common ownership above. Therefore, Inoue should be disqualified as prior art under 35 U.S.C. § 103(c). See M.P.E.P. § 706.02(l)(2).

With Inoue removed as prior art, Applicant respectfully submits that Kaspar does not disclose or suggest all of the features recited in claim 1. The teachings of Kaspar alone or in combination with Burk do not support a conclusion of obviousness because Kaspar, taken individually or together with Burk, does not disclose or suggest all of the features of claim 1. Reconsideration and withdrawal of these rejections are respectfully requested.

New Claims

New claims 7-11 have been added. Claims 7-11 depend from claim 1 and are allowable over the prior art for at least the reasons discussed above and for their respective additional recitations.

CONCLUSION

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 4/9/08

By P.D.S.

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

Paul D. Strain
Attorney for Applicant
Registration No. 47,369